

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

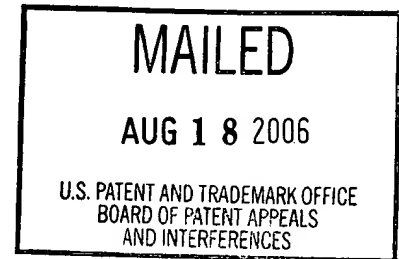
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MATHEW MCPHERSON

Appeal No. 2006-1834
Application No. 09/852,253

ON BRIEF



Before JERRY SMITH, RUGGIERO, and HOMERE, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 2, 4-23, and 25-27, which are all of the claims pending in this application. Claims 3 and 24 have been canceled. As indicated at pages 8 and 9 of the Answer, the Examiner has withdrawn the obviousness-type double patenting rejection of claims 1, 4-6, 9-23, and 25-27. Accordingly, only the Examiner's 35 U.S.C. § 103(a) rejection of claims 1, 2, 7, 8, 20-23, and 25-27 is before us on appeal.

The claimed invention relates to an acoustic guitar structure including a sound box having a sound board. The sound board is constructed of no more than two wood layers bonded together with the first and second layers made of different types of wood.

Claim 1 is illustrative of the invention and reads as follows:

1. An acoustic guitar, the guitar having a body having a soundboard, the soundboard comprising a first layer and a second layer, both layers being bonded together, wherein the first and second layers are made of different types of wood, wherein the sound board comprises no more than [sic] two layers of wood bonded together.

The Examiner relies on the following prior art:

Oehrlein	168,665	Oct. 11, 1875
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Petek	2,674,912	Apr. 13, 1954
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Irving Sloane (Sloane), STEEL-STRING GUITAR CONSTRUCTION, E.P. Dutton & Co., Inc., New York, page 19 (1975).

Claims 1, 2, 7, 8, 20-23, and 25-27 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Petek in view of Sloane with respect to claims 1, 2, 7, 8, 20, 21, 23, and 25, and adds Oehrlein to the basic combination with respect to claims 22, 26, and 27.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

¹ The Appeal Brief (second) was filed November 28, 2003. In response to the Examiner's Answer mailed March 26, 2004, a Reply Brief was filed May 26, 2004, which was acknowledged and entered by the Examiner as indicated in the communication dated June 21, 2004.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1, 2, 7, 8, 20-23, and 25-27. Accordingly, we affirm.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 1 based on the combination of Petek and Sloane, after reviewing the Examiner's analysis (Answer, pages 3 and 4), it is our opinion that the stated position is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellant to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed waived [see 37 CFR § 41.37(c)(1)(vii)].

With respect to independent claim 1, Appellant's arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination of Petek and Sloane has not been established. According to Appellant (Brief, page 5), the ordinarily skilled artisan would not have been motivated to utilize Sloane's two layer sound board teaching to modify the three layer sound board of Petek by making Petek's sound board of only two layers. In Appellant's view (id.), Petek "teaches away" from the use of only a two layer sound board since Petek's disclosure requires a three-layer board, i.e., two relatively stiff outer layers and a relatively light-weight inner layer.

After careful review of the disclosures of Petek and Sloane in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in

the Answer. In our view, Petek's disclosed invention is directed to an improvement over a single solid layer instrument sound board through the use of a laminated sound board having multiple layers made of at least two different materials. (Petek, column 1, lines 7-13). While Petek's preferred implementation of such a laminated sound board may be a three layer construction, we do not find in Petek any support for Appellant's conclusion that such a three layer board is required or any disclosure which may be said to "teach away" from a two layer sound board. Each reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. It is improper to downgrade a reference on the basis that it teaches away, unless it teaches away in the context of the combination of references. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., Inc., 800 F. 2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

We recognize that, at pages 1 and 2 of the Reply Brief, Appellant has amplified his arguments against the Examiner's obviousness rejection by asserting that the paragraph of Sloane relied upon by the Examiner for teaching a two layer sound board actually is directed to the construction of the backs and sides of guitars, not the sound board. We do not find this persuasive. While Appellant is correct that the cited paragraph of Sloane in question does state that "[r]osewood-veneered plywood is also available for backs and sides," the immediately succeeding sentence states that plywood is also used for the tops of guitars which would include the sound board.

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 1, as well as dependent claims 20, 21, 23, and 25 not separately argued by Appellant, is sustained.

We also sustain the Examiner's obviousness rejection of dependent claims 2, 7, and 8 based on the combination of Petek and Sloane. Although grouped separately by Appellant (Brief, page 4), the argument by Appellant for each of these claims asserts that the combination of Petek and Sloane does not provide for a sound board with only two layers in which the layers are of different types of wood. As we discussed earlier with regard to independent claim 1, we find in Petek a clear disclosure (column 1, lines 7-13) of providing a sound board with multiple layers utilizing at least two different types of wood. We also reiterate our finding of no error in the Examiner's stated position of obviousness in view of Sloane to modify the sound board of Petek to have only two layers.

Further, it appears to us, for the reasons articulated in the Answer, that the Examiner has made a reasonable case for the obviousness to the ordinarily skilled artisan of selecting from the types of wood disclosed by Petek and Sloane to provide the specific wood type layer combination set forth in claims 7 and 8. Accordingly, the burden is shifted to Appellant to overcome this prima facie case of obviousness. We find, however, no evidence from Appellant on the record before us of any indication of the criticality of the use of the particular wood type layer combinations recited in dependent claims 7 and 8,

with the claimed “cedar/spruce” and “redwood/spruce” combinations being described by Appellant’s specification (page 7, line 1) as “combinations of interest.”

We next consider the Examiner’s 35 U.S.C. § 103(a) rejection, based on the combination of Petek, Sloane, and Oehrlein, of dependent claims 22, 26, and 27 directed to the perpendicular grain direction feature of the claimed two layer sound board. Initially, we agree with Appellant (Brief, pages 7 and 8) that the Oehrlein reference has little teaching value with regard to the claimed sound board on appeal before us. As argued by Appellant, Oehrlein’s disclosure relates to the bottom board of a guitar, not the sound board. Further, Oehrlein specifically discloses (column 3, lines 5-8) that his invention does not relate to sound boards.

Upon review of the Petek and Sloane references, however, it is our view that Oehrlein is not required for a proper rejection under 35 U.S.C. § 103(a). As asserted by the Examiner, the existing combination of Petek and Sloane will result in a two-ply plywood sound board with the grain direction of the two layers running in perpendicular directions as claimed. We find particularly compelling the evidence provided by the Examiner (Answer, pages 7 and 8) in the form of a dictionary definition of “plywood” provided by Webster’s II New Riverside University Dictionary describing a plywood structure as one in which layers of wood are glued together with the grains of adjoining layers at right angles to each other. We also make the observation that, although Appellant filed a Reply Brief, no argument and/or evidence was presented in rebuttal of

the Examiner's position. Accordingly, since the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 22, 26, and 27 based on the combination of Petek and Sloane.²

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 2, 7, 8, 20-23, and 25-27 is affirmed.

² The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED

Gerry Smith
JERRY SMITH

Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO

Administrative Patent Judge

Jean R. Homere
JEAN R. HOMERE

Administrative Patent Judge

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